

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

KIRIL A. PANDELISEV

Serial No.: 09/881,091

Art Unit: 1731

Filed: June 15, 2001

Examiner: J. Hoffmann

For: HOT SUBSTRATE DEPOSITION FIBER OPTIC PREFORMS AND PREFORM  
COMPONENTS PROCESS AND APPARATUS

### RESPONSE

To the Director of Patents and Trademarks

Sir:

In response to the office action dated April 2, 2004, the applicant has tried to resolve the species election requirement in responses filed and in the face-to-face interview.

Even after the interview, it is not understood what would be an acceptable set of claims drawn to an elected species, or for that matter what an acceptable elected species would be.

The applicant again elects the species previously elected and the previously identified claims.

The applicant requests the examiner to conform the elected species to the elected claims that read thereon.

To avoid further delay in prosecution, the applicant requests that the examiner indicate what would be acceptable to the examiner.

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For example:

The species of Figure 1 or the species of Figure 19.

Claims 63, 65-67, 78-82, 84, 86b and 89 have already been examined, making the examiner's arguments about species elections moot.

The invention shows forming and using boules by forming and doping (Figures 1-9, 11A, 19-25) and fusing, softening and drawing (Figures 15-25), and intermediate products (Figures 10A-10D, 11B-14D).

It is pointed out that Figures 1-9 and 11A are substantially identical and are basically different views of the same subject matter. The same is true of Figures 15-18, 19-21 and 22-25.

The entire invention is unitary, and only four species are shown.

The method and apparatus as claimed are identical, and the method as claimed cannot be performed by hand and cannot be performed by a different apparatus.

The product as claimed cannot be made by another and materially different process, and the process as claimed cannot make another and materially different product.

In a first office action, the examiner identified Groups I, II and III and 43 sub species A1-P6.

The applicant provisionally elected Group II with traverse.

In a second office action, the examiner required the species election.

The applicant provisionally elected Group II and the particular species of the alpha numeric designations, listed the claims readable on the elected species and identified linking claims; the applicant identified allowable generic claims and traversed the requirements.

In a third office action dated 8/13/03, the examiner argued that claims 68-72 did not read on C3, but C2, claim 103 was not a method claim and claim 137 is directed to N2, not N1, and claim 22 does not read on A1.

The examiner made an unusual holding that what the examiner had identified as a species MCVD was not even in the application disclosure or claims and required deposition in the substrate, not "on" the substrate, and that as a result all claims would be withdrawn.

The applicant argued against restriction and the examiner's holding.

In the fourth office action, the examiner refused to withdraw the election requirement, objected to some claims, and rejected claims on Abe. The examination process had begun.

In a response the applicant amended some claims, argued against restriction and argued against application of Abe, and argued for allowance of all claims.

In the fifth office action, the examiner apparently dropped his art rejection, and the examiner repeated his refusal and again argued an incorrect and unbiased interpretation of species E1.

The applicant responded that MCVD does not mean deposition from within the substrate.

In the sixth office action, the examiner argued that MCVD meant something that was not in the disclosure or in the claims.

Established procedure supports that applicant's position against unreasonable species requirements that are not supported by the disclosure and claims.

MPEP 806.04(a) Species-Genus begins under the title SPECIES ARE TREATED EXTENSIVELY IN THE FOLLOWING SECTIONS.

806.04(a) provides that a reasonable number of species may still be claimed in one application.

806.04(b) states Species ... may be related under the particular disclosure.

806.04(e) points out:

Species are always the specifically different embodiments.

The sum total of the species election requirement is that the applicant should elect species and identify claims. That has already been accomplished. Claims have been examined on merits.

It is understood that art rejections have not been repeated, and formal requirements have been met, making those claims allowable.

The applicant requests final action so that appropriate appeal and petition, if required, may be filed.

To the extent that the examiner has identified a species by initial letters not identified at the time with words, and to the

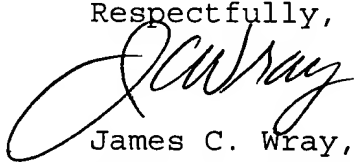
extent that the examiner has held those letters to mean something which he had not revealed and which is not disclosed, discussed or shown within the application, the examiner has erred, at least to the extent of his five E sub species designations.

The applicant relies on its election of the fifteen other non-errant species designations:

A, B, C, D, F, G, H, I, J, K, L, M, N, O, P

which are arbitrary and excessive in themselves, ,but for which sub species have been elected as required, and requests reconsideration and allowance of all claims.

Respectfully,



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